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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,859	01/26/2006	Yoshimitsu Kagiwada	SHIO-0045	7901
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WRIGHT, BRYAN F				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/533,859

**Applicant(s)**

KAGIWARA, YOSHIMITSU

**Examiner**

BRYAN WRIGHT

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2, 7, and 11-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2, 7 and 11-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/24/2009 has been entered. Claims 2, 7, 11, and 14 have been amended. Claims 1, 3-6, and 8-10 are cancelled. Claims 17 and 18 are new. Claims 2, 7, and 11-18 are pending.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 2 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Examiner contends applicant's newly amended claim subject matter of, "first" and "second" the context of commodity provision information does have support.

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More precisely, applicant's formal usage of "first commodity provision information" and a "second commodity provision information" as amended does have original disclosure support. Furthermore, Examiner contends the amended subject matter of, "said identifying by using the second commodity provision information on a specific commodity as a key such that the received commodity provision information partially or completely coincides with the first commodity provision information" does not have support of original disclosure on the basis that the "identifying" for which applicant's claim language recites depends on the "second commodity provision information" for which Examiner contends is new subject matter that lacks supports of original disclosure.

2. Claims 11 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Examiner contends applicant's newly amended claim subject matter of, "first" in the claimed context of "first commodity provision information does have original disclosure support.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Regarding claim 2, the phrase "etc." renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 7, 11, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsui et al. (US Patent Publication No. 2002/0019817 and Matsui hereinafter (cited from IDS)) in view of Freishtat et al. (US Patent Publication No. 2001/0037294 and Freishtat hereinafter).

5. 1. (cancelled).

6. As to claim 2 and 7, Matsui teaches a personal information utilization system comprising: a personal information storage means, a communication means to an external device, and an information processing means for controlling operation of each means thereof (i.e., ... teaches database storage, internet communication and computer system for processing [fig. 1]);

said personal information storage means not only storing personal information on an information disclosing person but also storing commodity provision information, etc. on first commodity service which is provided for said information disclosing person for each information disclosing person of said personal information (i.e., ... teaches a database storage storing personal information and service related information [6, fig. 2]);

and said processing means being constituted by the following steps:

a) receiving second commodity provision information (i.e., teaches information entered via web browser [fig. 4; fig. 5]), etc. from an information search side terminal via said communication means (i.e., ... teach a search configuration for searching [fig.6]),

b) checking said received second commodity information with the first commodity provision information (i.e., ... teaches performing a search based information receive with stored information [fig. 6]),

c) identifying, as a result of said checking an information disclosing person associated with said first commodity provision information (i.e., ... teaches identifying a person matching said information [par. 55]), received second commodity provision information partially or completely coincides with the first commodity provision information (i.e., ... teaches performing a search relative to designated service information received [0056]),

d) reading out one or more personal information on said identified information disclosing person or persons from said personal information storage means (i.e., ... teaches displaying said result of search [fig. 6],

e) transmitting said read out personal information on the information disclosing person or persons to said information search side terminal (i.e., ... teaches a sending a report base query information provided [par. 56]).

Matsu does not expressly teach:

said identifying by using the second commodity provision information on a specific commodity as a key such that the received commodity provision information partially or completely coincides with the first commodity provision information,

However, these features are well known in the art and would have been an obvious modification of the system disclosed by Matsu as introduced by Freishtat. Freishtat discloses:

said identifying by using the second commodity provision information (e.g., collected information identified for individuals) on a specific commodity (e.g., list of transaction [par. 63]) as a key (e.g., transaction type) such that the received second commodity provision information (e.g., collected information identified for individuals) partially or completely coincides with the first commodity provision information (e.g., originating personal information [fig. 5]) (to provide means to share and utilize personal information on a user (e.g., customers) [abstract lines 1-7]).

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Therefore, given the teachings of Freishtat, a person having ordinary skill in the art at the time of the invention would have recognized the desirability and advantage of modifying Matsu by employing the well known feature of sharing personal information disclosed above by Freishtat, for which personal information will be enhanced (abstract lines 1-7).

7. 3. - 6. (Canceled)

8. 8.- 10. (Canceled).

9. As to claim 11, Matsui teaches a personal information utilization system where the first commodity provision information, registered in said personal information storage means is such information that said processing means associates personal information of said information disclosing person and first commodity provision information, etc, (i.e., ... teaches a storage (i.e., database) contain personal information and associated service information [6, fig. 2]), and receives said associated information from an information register side terminal via said communication means (i.e., ... teaches a web browser [fig. 4] Further teaches registration user screen [15, fig. 3]);

checks said received personal information with personal information stored in said personal information storage means (i.e., ... teaches the use of a password and user id assigned for identification [0049 - 0051]);



identifies the information disclosing person of said received personal information, as a result of said checking, if said received personal information coincides with the personal information stored in said personal information storage means (i.e., ... teaches upon matching criteria [par. 55]);

and registers said commodity purchasing information, etc. received for each identified information disclosing person in said personal information storage means [18, fig.3].

10. As to claim 12, Matsui teaches a personal information utilization system where said information searching person includes at least a manufacture, a sales vendor, a service trader, a self-governing body or an education foundation [a, b, fig. 5].

11. As to claim 13, Matsui teaches a personal information utilization system where the personal information on the information disclosing person registered in said personal information storage means is such information that the processing means is allowed to receive information on disclosure limits representing disclosure limits for the personal information on the information disclosing person, from the information disclosure side terminal via the communication means and that the personal information storage means is allowed to manage in accordance with the received information on disclosure limits (i.e., ... teaches a web browser [fig.4] Further teaches said web browser displaying limited personal information required for search).

12. As to claim 14, Matsui teaches a personal information utilization program where the commodity provision information, registered in said personal information storage means is such information that said processing means is allowed to associate personal information of said information disclosing person and first commodity provision information (i.e., ... teaches a storage (i.e., database) contain personal information and associated service information [6, fig. 2]);

and to receive said associated information from the information register side terminal via said communication means (i.e., ... teaches a Web browser configuration for receiving personal information [fig. 4; fig. 7]);

to check said received personal information with personal information stored in said personal information storage means (i.e., ... teaches the use of a password and user id assigned for identification [0049 - 0051]);

to identify an information disclosing person of said received personal information as a result of said checking, if said received personal information coincides with the personal information stored in said personal information storage means (i.e., ... teaches upon matching criteria [par. 55]);

and to register said commodity purchasing information, etc. received for each identified information disclosing person in said personal information storage means [18, fig.3].

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13. As to claim 15, Matsui teaches a personal information utilization program where said information searching person includes at least a manufacturer, a sales vendor, a service trader, a self-governing body or an education foundation [a, b, fig. 5].

14. As to claim 16, Matsui teaches a personal information utilization program where the personal information on the information disclosing person registered in said personal information storage means is such information that the processing means is allowed to receive information on disclosure limits representing disclosure limits for the personal information on the information disclosing person, from the information disclosure side terminal via the communication means and that the personal information storage means is allowed to manage in accordance with the received information on disclosure limits (i.e., ... teaches a web browser [fig.4] Further teaches said web browser displaying limited personal information required for search).

15. As to claim 17, the system of Matsui teaches substantial features of the claimed invention, however does not disclose

A personal information utilization system where the first commodity provision information is automatically registered via an information register side terminal.

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However, these features are well known in the art and would have been an obvious modification of the system disclosed by Matsu as introduced by Freishtat. Freishtat discloses:

A personal information utilization system where the first commodity provision information is automatically registered via an information register side terminal (to provide registration means used within a personal information utilization information. Registration providing registration of particular PI provider (e.g., first commodity provision information) [par. 65]).

Therefore, given the teachings of Freishtat, a person having ordinary skill in the art at the time of the invention would have recognized the desirability and advantage of modifying Matsu by employing the well known feature of registration within a personal information sharing system disclosed above by Freishtat, for which personal information will be enhanced (par. 65).

16. As to claim 18, Matsui teaches personal information utilization system where the first commodity provision information comprises a name of an item, a name of a vendor, and a date when the vendor provided the item [a, b, fig. 5].

### ***Response to Arguments***

Applicant's arguments with respect to claims 2, 7, and 11-18 are pending have been considered but are moot in view of the new ground(s) of rejection.

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Examiner contends the teaching of Freishtat provides for the capability to provide means to share and utilize personal information on a user [abstract, lines 1-7].

### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRYAN WRIGHT whose telephone number is (571)270-3826. The examiner can normally be reached on 8:30 am - 5:30 pm Monday -Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, AYAZ Sheikh can be reached on (571)272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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